C. Remarks

The claims are 1-29, with claims 1-3 being addressed herein and claims 4-29 having been withdrawn from consideration as being drawn to non-elected subject matter; claim 1 is the sole independent claim under consideration at this time. Claims 1 and 2 have been amended to address the enablement issue raised by the Examiner. Support for this amendment may be found, for example, in claims 7 and 8. Claim 3 has been amended to improve its form. No new matter has been added. Reconsideration of the pending claims is respectfully requested.

Initially, Applicants' undersigned representative would like to thank the Examiner for the courtesies extended by the Examiner during telephonic interviews conducted on or about February 7, 2008 and April 4 and 8, 2008. During the interviews, the Examiner advised the undersigned that the enablement rejection of claims 1-3 would be withdrawn if these claims are rewritten in a product-by-process form, and that a sworn translation of the entire priority document would be needed for antedating purposes.

Claims 1-3 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to satisfy the enablement requirement. The Examiner has alleged that while the specification is enabling for the examples of copolymers having monomeric units, the specification is not enabling for the structures having specific units in specific ratios.

In response, as suggested by the Examiner, claims 1-3 have been amended into a product-by-process form. Applicants stress that this amendment was made solely to

expedite prosecution and should not be construed as an admission that the rejection was proper. Therefore, Applicants respectfully request withdrawal of the § 112 rejection.

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Imamura (U.S. Patent No. 7,045,321). Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Imamura alone or in view of Kenmoku (U.S. Patent No. 6,869,782). Applicants respectfully traverse these rejections.

Initially, Applicants would like to point out that Imamura is not prior art under 35 U.S.C. § 102(b). Imamura was first published on January 16, 2003, which is less than one year before the October 23, 2003 international filing date of the subject national stage application. Thus, Imamura is not prior art under 35 U.S.C. § 102(b). Furthermore, Applicants submit herewith a sworn translation of JP 2002-310250, filed October 24, 2002, from which the present application claims priority under 35 U.S.C. § 119. Therefore, Imamura is, at most, prior art under 35 U.S.C. § 102(e).

As previously pointed out by Applicants, Imamura does not disclose a copolymer comprising the monomer units as recited in the present claims. Imamura teaches employing one monomer that is used in the present invention to make another monomer that is used in the present invention (see Imamura, claims 30 and 31), but does not disclose or suggest the combination of those two monomers to make the copolymer of the present invention.

The Examiner has alleged that Imamura teaches a process for preparing the unit of formula (1) in which the same microorganism is cultured with a substrate by

essentially the same procedure as in the instant application, and therefore, inherently provides to the claimed product. However, Applicants respectfully submit that the PHA comprising the unit of formula (1) as presently claimed, formed in Imamura using a microorganism, is not disclosed to be a **co**polymer (see formulas (28) and (29) in claims 30 and 31), much less the one as presently claimed. Particularly, since Imamura discloses that the PHA of formula (28) is produced by culturing a microorganism with a raw material of formula (29) and no other raw material is mentioned, the resulting PHA is not a inherently a copolymer as claimed. Imamura does not recite copolymers that include the monomer unit of formula (1) as presently claimed. Thus, clearly, Imamura does not anticipate the claimed invention.

Kenmoku also does not disclose the presently claimed copolymer. Particularly, this document does not disclose a copolymer including the monomer unit of formula (1) as recited in the present claims. Therefore, like Imamura, Kenmoku does not anticipate the present claims.

Applicants respectfully submit that neither Kenmoku nor Imamura can be used as prior art to render the present claims obvious in view of the provisions of 35 U.S.C. § 103(c). Specifically, as discussed above, Imamura qualifies as prior art only under 35 U.S.C. § 102(e). Kenmoku also qualifies as prior art only under § 102(e), since it was published on June 12, 2003, which is after the October 24, 2002 filing date of the above-mentioned Japanese priority application. Thus, since Imamura, Kenmoku and the claimed

invention were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Canon Kabushiki Kaisha,[1] and since Imamura and Kenmoku are prior art only under § 102(e), these publications cannot be used as prior art in an obviousness rejection in view of 35 U.S.C. § 103(c).

For at least these reasons, Applicants respectfully request withdrawal of the outstanding rejections.

In view of the foregoing remarks, favorable reconsideration and passage to issue of the present claims is respectfully requested. Should the Examiner believe that issues remain outstanding, the Examiner is respectfully requested to contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

This Amendment After Final Rejection should be entered, because it places the case in allowable form by resolving all outstanding issues.

[1] Assignments in Imamura, Kenmoku and the subject application are recorded, respectively, at reel/frame 014305/0368; 013084/0503; and 017360/0208.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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